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Mark Lesswing

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King & Spalding LLP (Trizetto Customer Number)
1700 Pennsylvania Avenue N.W. Suite 200
Washington, DC 20006

EXAMINER

FRENEL, VANEL

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* MARK LESSWING and DALE HOERLE
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11 Appeal 2009-003775
12 Application 09/577,386
13 Technology Center 3600
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16 Decided: March 29, 2010
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20 *Before:* MURRIEL E. CRAWFORD, HUBERT C. LORIN, and BIBHU R.
21 MOHANTY, *Administrative Patent Judges.*

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23 CRAWFORD, *Administrative Patent Judge.*
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26 DECISION ON REQUEST FOR REHEARING

INTRODUCTION

Appellants filed a Request for Reconsideration (filed November 23, 2009, hereinafter “Request”) under 37 C.F.R. § 41.52 (2009) contending that the Board, in the Decision on Appeal (mailed November 10, 2009, hereinafter “Decision”) erred in affirming the rejection of claims 60 to 86 under 35 U.S.C. § 103(a) (2002) as being unpatentable over Tarter (US 5,704,044, patented Dec. 30, 1997) in view of Dart (US 6,529,876 B1, patented Mar. 4, 2003). Appellants hereby request that we reconsider and reverse the Examiner’s rejection of claims 60 to 86. In the Decision on Appeal the Board reversed the Examiner’s rejection of claims 1 to 11 and 24 to 59 and affirmed the Examiner’s rejection of claims 60 to 86.

Appellants argue that we erred in holding that the Appellants did not rebut the Examiner’s case of obviousness. In our original Decision, we held that the Examiner met the initial burden of establishing a case of obviousness for the subject matter of claims 60 to 86 and thus the burden shifted to Appellants to rebut the case of obviousness (Decision 11 to 12). We further held that since the Appellants set forth only general assertions that the cited prior art did not disclose the subject matter of the claims, the Appellants did not meet that burden. As we said in our original Decision at page 12, the Appellants’ entire argument consisted of quoting aspects of the various claims without any discussion as to why the prior art does not render obvious the recitations in the claims.

In this request, the Appellants argue that they did identify what the references failed to teach or suggest and were under no obligation to discuss what the references disclose.

1 While the Appellants may not be under an obligation to discuss what
2 the cited references disclose, Appellants did have a burden of establishing
3 why the references failed to disclose the subject matter of the claims.

4 For example, in regard to claim 60, the Examiner in the Final
5 Rejection found that the various recitations in the claim were disclosed in
6 Tarter at column 1, lines 19 to 67, column 2, line 67, column 13, lines 44 to
7 67, column 14, line 65 and in Dart, column 19, lines 1 to 18 and column 20,
8 lines 6 to 68. The Examiner made reference to these portions of Tartar and
9 Dart with reference to the individual recitations in the claim (Final Rej. 22 to
10 23).

11 The Appellants did not discuss the specific portions relied on by the
12 Examiner in the Tarter and Dart references. The Appellants did not discuss
13 any portions of the Tartar and Dart disclosures. Appellants' total argument
14 in the Appeal Brief was:

15 Independent claim 60 recites, in part,
16 "associating, with said at least one term,
17 information, stored to computer-readable medium,
18 representing at least one qualifier having a
19 corresponding calculation method, wherein the at
20 least one qualifier identifies at least one condition
21 to be satisfied by a claim for reimbursement in
22 order to trigger the corresponding calculation
23 method." The applied combination of *Tarter* and
24 *Dart* fails to teach or suggest at least this element
25 of claim 60.

26 Therefore, Appellant[s] respectfully
27 request[] that this rejection of claim 60 be
28 overturned.

29 (App. Br. 34).

1 This statement by the Appellants in the Brief, and the similar
2 statements in the Brief regarding claims 61 to 86 amounts to quoting an
3 aspect of claim 60 along with a general assertion that the cited references fail
4 to teach this element of claim 60 and is not sufficient to rebut the
5 Examiner's case of obviousness.

6 For the first time in this Request, the Appellants argue that the
7 Examiner's rejection fails to provide a sufficient reasoning in support of the
8 rejection because the Examiner did not provide a discussion as to why the
9 referenced portions of the references relied on disclosed the recitations in the
10 claims. This is an argument that the Appellants could have made in the
11 Brief to rebut the Examiner's rejection. The Appellants did not make this
12 argument. As such, we will not address this argument at this point.

13 The Appellants also argue that they had no burden to discuss what the
14 references disclose in order to rebut the Examiner's case of obviousness. It
15 is not that the Appellants had a burden to discuss what the references
16 disclose but rather, it was necessary for the Appellants to explain why the
17 rejection was in error to thereby rebut the Examiner's case of obviousness.
18 While an argument that the references do not disclose an element of a claim
19 may be considered an argument, the argument is not of sufficient weight to
20 rebut the Examiner's case of obviousness.

21 While we have considered an elaborated on certain aspects of our
22 original Decision in light of Appellants' request, we decline to modify our
23 original Decision in any respect.

1 No time period for taking any subsequent action in connection with
2 this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.
3 § 1.136(a)(1)(iv) (2007).

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5 DENIED
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16 King & Spalding LLP (Trizetto Customer Number)
17 1700 Pennsylvania Avenue N.W. Suite 200
18 Washington, DC 20006